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Sheryl L. Hatchings
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Toshiyasu Yabe et al.

Appln. No.: 10/526,114

Filed: November 3, 2005

For: PERMISSION-BASED
ELECTRONIC MAIL DELIVERY
SYSTEM (As amended)

Examiner: Nilanont, Youpaporn

Art Unit: 2446

Conf. No.: 8518

Attorney Docket No.: 9683/231

SECOND REQUEST FOR REFUND AND FURTHER REVIEW

MAIL STOP 16
Director of the U.S. Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a second request for refund and a request for further review of the record of the above-referenced application. On April 21, 2010, Applicant requested a refund to Deposit Account No. 23-1925, in the amount of \$1650 **due to an error by the U.S. Patent and Trademark Office**. The first refund request was denied on May 21, 2010. However, Applicant believes this denial to be improper, and respectfully insists on a further review of the facts as presented herein.

1. A Final Office Action was mailed August 18, 2009. An After Final Response was filed on October 18, 2009. On November 3, 2009, **the Examiner erroneously issued an Advisory Action instead of a non-final Office Action**, stating:

Although Examiner agrees that the cited references do not appear to disclose all the limitations of the independent claims, i.e., wherein the terminal station being controlled by the relay device to register its user's email address to the transmitting apparatus, however, the claims do not appear to be in condition for allowance. **Further search is required and the Office will send another non-final Office Action. (The applicant is not required to submit any further reply.)** (emphasis applicant's)

A copy of the erroneously issued Advisory Action is attached hereto as Exhibit A.

2. The erroneously issued Advisory Action was followed by further error on the part of the U.S. Patent and Trademark Office in not timely issuing a non-final Office Action to correct the first error. Instead, the non-final Office Action eventually issued on March 22, 2010, and a copy of page 2 is attached hereto as Exhibit B. As indicated in the Detailed Action section, Page 2, Paragraph 1, of the Office Action, confirmation of the erroneously issued Advisory Action is indicated:

In view of the Amendment After Final Action filed on 10-19-2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below. **Please disregard Advisory Action mailed November 11-03-2009 and Supplement Action mailed 2-23-2010 which are made in mistake.** (emphasis applicant's)

3. Despite indications to the contrary in the erroneously issued Advisory Action issued November 3, 2009, the U.S. Patent and Trademark Office did not correct this error by issuing a non-final Office Action by the February 18, 2010, abandonment date of the present application. In order to avoid abandonment of the application due to the U.S. Patent and Trademark Office's failure to timely act, Applicant was forced to file a Notice of Appeal, including payment of the requisite extension of time fees, totaling \$1650.

4. On February 19, 2010, the U.S. Patent and Trademark Office debited Deposit Account No. 23-1925 in the amount of \$1110.00, (at Seq. 8657 on February 19, 2010, Posting Ref. Txt. 10526114, Attorney Docket Nbr. 9683/231, Fee Code 1253, Amt, \$1110) for the extension of time of three months. The U.S. Patent and Trademark Office also debited Deposit Account No. 23-1925 in the amount of \$540 (at Seq. 8658,

on February 19, 2010, Posting Ref. Txt. 10526114, Attorney Docket Nbr. 9683/231, Fee Code 1401, Amt. \$540) for the Notice of Appeal.

SUMMARY

The U.S. Patent and Trademark Office **acted erroneously** in issuing the Advisory Action on November 3, 2009, and **erroneously failed to act in a timely manner** following Applicant's Response filed on October 18, 2009, in that the Office did not send another non-final Office Action as stated in the Advisory Action dated November 3, 2009. As such, Applicant was forced to file a Notice of Appeal, due to the U.S. Patent and Trademark Office's multiple errors, in order to avoid abandonment of this application. **Applicant respectfully requests a refund of \$1650 that was required to be paid to prevent abandonment of the application until the errors by the U.S. Patent and Trademark Office could be corrected.**

Respectfully submitted,

 July 29, 2010
Sanders N. Hillis
Attorney Reg. No. 45,712
Attorney for Applicant

SNH/slh

BRINKS HOFER GILSON & LIONE
CUSTOMER NO. 27879
Telephone: 317-636-0886
Facsimile: 317-634-6701

Exhibit A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,114	11/03/2005	Toshiyasu Yabe	9683/231	8518

EXAMINER	
NILANONT, YOUNAPORN	

ART UNIT	PAPER NUMBER
2446	

MAIL DATE	DELIVERY MODE
11/03/2009	PAPER

27879 7590 11/03/2009
 INDIANAPOLIS OFFICE 27879
 BRINKS HOFER GILSON & LIONE
 CAPITAL CENTER, SUITE 1100
 201 NORTH ILLINOIS STREET
 INDIANAPOLIS, IN 46204-4220

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

COPY

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 USPTO
 GILSON & LIONE

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/526,114

Applicant(s)

YABE ET AL

COPY

Examiner

YOUAPORN NILANONT

Art Unit

2446

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 19 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).
Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any named patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____ (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): Claim rejections under 35 U.S.C. 103 with respect to claims 13-32.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: _____
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

/Jeffrey Pwu/
Supervisory Patent Examiner, Art Unit 2446

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Continuation of 11, does NOT place the application in condition for allowance because:

Although examiner agrees that the cited references do not appear to disclose all the limitations of the Independent claims, i.e. wherein the terminal station being controlled by the relay device to register its user's email address to the transmitting apparatus, however the claims do not appear to be in condition for allowance. Further search is required and the Office will send another non-final Office Action. The applicant is not required to submit any further reply.

COPY

Application/Control Number: 10/526,114
Art Unit: 2446

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Page 2

DETAILED ACTION

In view of the Amendment After Final filed on 10-19-2009, PROSECUTION IS
HEREBY REOPENED. New grounds of rejection are set forth below. Please disregard
Advisory Action mailed November 11-03-2009 and Supplement Action mailed 2-23-
2010 which are made in mistake.

To avoid abandonment of the application, appellant must exercise one of the
following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply
under 37 CFR 1.113 (if this Office action is final); or,

(2) Initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed
by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and
appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth
in 37 CFR 41.20 have been increased since they were previously paid, then appellant
must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by
signing below:

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2446.

Status of Claims:

Claims 13-32 are pending in this Office action.